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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,430	03/17/2004	Robert Frank Porreca	Porrec.R-01	5561
22197 7590 07/12/2007 PATENT LAW & VENTURE GROUP 2424 S.E. BRISTOL, SUITE 300 NEWPORT BEACH, CA 92660			EXAMINER PSITOS, ARISTOTELIS M	
			ART UNIT 2627	PAPER NUMBER
			MAIL DATE 07/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/803,430	<b>Applicant(s)</b> PORRECA, ROBERT FRANK	
	<b>Examiner</b> Aristotelis M. Psitos	<b>Art Unit</b> 2627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

Applicant's response of 5/14/07 has been considered with the following results.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 and 7 and 8-10 are rejected under 35 U.S.C. 101 because:

As best interpreted, as presented, the claims as a whole encompasses a human being, i.e., a user – see MPEP 2105 – last full paragraph.

With respect to method claims 8 –10 the examiner recommends deleting any mentioning of a user. The method claim appears should be drawn to a method of creating a customized playlist.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1-3,7 as well as 8-10 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The claims are incapable of yielding the desired result without a user and computer/system.

However, see MPEP section 2173.05 (g) last paragraph. Also, no computer/controller is positively recited to yield any operation(s)/performance upon the set of instructions.

As far as the claims recite positive limitations, the following rejections are made.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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1. Claims 1-3,7 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hooban further considered with Van Ryzin and both further considered with either Laarman or McKean.

With respect to claim 1,

Hooban discloses a manufacturing system, having user interfacing with appropriate elements in order to create an end product. The end product is a collection of songs. This product is then finally packaged.

The examiner interprets the selection of songs/albums as a set of instructions and meeting the claimed program for receiving user inputted song information.

Furthermore, Van Ryzin – see fig. 5 for instance – further discloses a set of instructions for customized playlist creation.

Finally, either the Laarman or McKean document discloses “jewel” cases with the appropriate inserts.

It would have been obvious to modify the base system of Hooban with the additional teachings from Van Ryzin and either Laarman/McKean in order to yield a final packaged product in an appropriate foldable menu configured to hold a printed insert.

With respect to claim 2, the ability of having an interactive set of instructions so as to add to the selected list is met by the above combined teachings/see the discussion in either Hooban for selecting of plural songs/ and or Van Ryzin for his playlist creation.

With respect to claim 7, such is present in either of the systems to McKean/Laarman.

With respect to claims 8 and 9, these method steps are met when the above system operates.

With respect to claim 10, such is considered an obvious set of instructions for performing a final print of the customized playlist. A set of such instructions would have a start and end, a selection of information to be recorded, artist, title etc., a decision point – one selection, multiple selection, a decision point – end of selection(s), and the final print decision.

#### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

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In addition, applicant's attention is also drawn to MPEP 2112.01 III. The examiner takes the position that the printed matter – software instructions are not functionally related to the substrate (card stock sheet or foldable menu), and hence this printed matter does not distinguish over the above art of record. The software is functionally related to a computer in order to perform the instructions, not the card stock.

### ***Conclusion***

Applicant's attention is also drawn to Mastronardi and Dockes et al. Either of these systems could be used in place/lieu of the base reference to Hooban in the above 103 rejections.

Mastronardi permits/discloses a user selecting a distribution system having appropriate labels printed for the final product – see for instance the discussion with respect to figure 6.

Dockes et al also discloses a user interfacing system providing a final cd product with appropriate information printed on the jackets thereof – see the abstract for instance.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

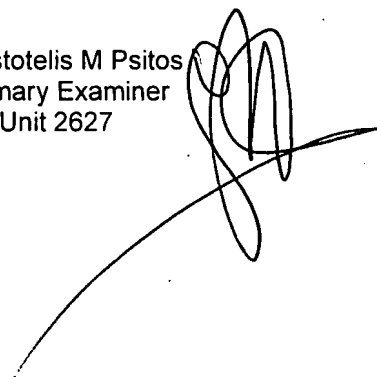
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-F: 6:00 - 2:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aristotelis M Psitos  
Primary Examiner  
Art Unit 2627

A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke extending to the right.

AMP